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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,609	06/29/2001	Hugh R. Sharkey		7298

23715 7590 08/11/2003

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EXAMINER
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PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 08/11/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/895,609

Applicant(s)

SHARKEY ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-45, 47-50, 60-76 and 81-92 is/are pending in the application.
- 4a) Of the above claim(s) 81-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-45, 47-50, 60-76, 91 and 92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20. 6) ☐ Other: \_\_\_\_\_

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 9, 2003 has been entered.

It is noted that claims 41-45, 47-50, 60-76 and 81-92 are currently pending. Claims 81-90 remain withdrawn from consideration as being directed to an invention non-elected by original presentation (see Paper No. 17), and claim 91 and 92 have been newly added with the submission of July 9, 2003.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41-44, 47-50, 60, 61, 63-65, 67-69, 71-76, 91 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by Parins ('963).

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Parins discloses a device which comprises a probe member (30) having proximal and distal ends and a lumen and first and second electrodes (96,98) extending through the probe. The electrodes make up a bipolar pair (i.e. active and return electrodes) and are connected to leads (102,104) which may be covered with an insulation (col. 5, lines 50-55). The electrodes extend across a portion of the aperture, extend in a parallel relationship, and form a partial loop or hook shape (Figure 4). The electrodes are movable relative to the sheath such that they may extend across the aperture proximal to, distal to, or directly across the aperture. Parins also disclose the use of an aspiration device (154) for aspirating fluid through a lumen in the probe.

Claims 41-43, 45, 47-50, 60, 62, 63, 65-68, 70, 71, 73, 74 and 91 are rejected under 35 U.S.C. 102(e) as being anticipated by Blewett et al ('521).

Blewett et al provide a device comprising an elongate probe member (24) having proximal and distal portions and a distal surface, a lumen extending therethrough having an aperture (34), and a bipolar pair of electrodes (38a) connected to insulated leads and extending from the probe and across the aperture. The first and second electrodes are spaced outwardly from the distal face (Figure 16) and the electrodes have the shape of a prong. The electrodes extend from the distal face parallel from each other, then curve downward and extend in the same plane (i.e. transverse to the longitudinal axis of the probe). The electrodes extend from a sidewall of the distal end of the probe (Figures 2 and 16).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 75, 76 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blewett et al ('521) in view of the teaching of Parins ('963).

The Blewett et al device has been addressed previously. Blewett et al fails to specifically disclose the use of an aspiration source to aspirate fluid/material through the lumen (34) of the device. Blewett et al does disclose that a working channel (114) is provided in the device for providing alternative tools to the site, or may be used as an irrigation conduit to provide fluid to tissue (col. 6, lines 1-18). It is the examiner's position that irrigation and aspiration controls are generally interchangeable in such devices depending on the specific needs, and that such lumens often are used to provide both functions.

Parins teaches an analogous endoscope device and specifically teach that a lumen in the device may be used to provide either a fluid for irrigation, or a source of aspiration to remove material from the treatment site (col. 5, lines 37-40).

To have provided the Blewett et al device with an aspiration means for removing fluid from the treatment site would have been an obvious modification for one of ordinary skill in the art, particularly since Blewett et al provide a lumen for irrigation and

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Parins teaches that such lumens may be used to provide irrigation and/or aspiration to tissue.

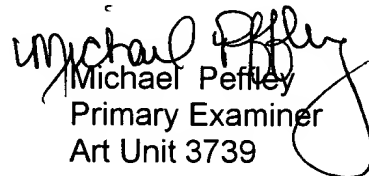
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Feinberg et al ('598), Hagen ('998), Issa ('280), Hooven ('044) and Woloszko et al ('237) all disclose bipolar electrodes which extend across an aperture in an elongate member for treating tissue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

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August 6, 2003